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09/842,613	04/26/2001	Philip L. Taylor	MBX 034 CON (2)	9397

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EXAMINER
YOON, TAE H

ART UNIT	PAPER NUMBER
1714	

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Please find below and/or attached an Office communication concerning this application or proceeding.

HG

Office Action Summary	Application No. 09/842,613	Applicant(s) Taylor
	Examiner T. Yoon	Group Art Unit 1914

—Th MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

P riod for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on 12-24-02.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1 and 11-26 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1 and 11-26 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)–(d)

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)–(d).

☒ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☒ Certified copies of the priority documents have been received in Application No. 08/776,264.

☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____.

Attachment(s)

☐ Information Disclosure Statement(s), PTO–1449, Paper No(s). _____

☐ Interview Summary, PTO–413

☐ Notice of Reference(s) Cited, PTO–892

☐ Notice of Informal Pat nt Application, PTO–152

☐ Notice of Draftsperson's Patent Drawing Review, PTO–948

☐ Other _____

Office Action Summary

Amendment is objected since it lack consistency or accuracy. For example, "further" in line 1 of claim 15 and "about" in line 2 of claim 21 have not been underlined.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1 and 11-26 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 11-26 of copending Application No. 09/232,110. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Rejection is maintained since applicant neither submitted a terminal disclaimer nor caanceled claims 1 and 11-26 of copending Application No. 09/232,110.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 11-26 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a water-resistant film-forming composition at ambient

temperatures comprising 10 wt% of a film-forming acrylic latex and 90 wt% of a polyhydroxyalkanoate ((co)polyester) as in the examples 1 and 2, does not reasonably provide enablement for the instant claim reciting a (co)polyester. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

The instantly recited polyhydroxyalkanoate (co)polyester encompasses an amorphous (co)polyester (non-crystalline (co)polyester in another words), and note applicant's statement in the bridging paragraph on pages 5 and 6 of the Appeal Brief for 09/232,110 wherein the relationship of the density and the crystallinity is stated. Thus, a non-crystalline or an amorphous (co)polyester would have the lowest density) which will neither crystalize nor fuse at ambient temperatures. There is no evidence that said (co)polyester **alone** forms a water-resistant film or fuse at ambient temperatures. The film of the instant examples of the specification is due to the presence of 10 wt% of a film-forming acrylic latex. The examples do not commensurate in scope with the claim. Note that the requirement in the claim 1 is only an aqueous (co)polyester and that the dependent claim 13 reciting other film forming polymers does not have any amount thereof. Thus, even the presence of 0.1 or 1 wt% of said other film forming polymers or no presence of said other film forming polymers falls within the scope of the instant invention, but applicant failed to show a film fomation therefrom. Also, as pointed out by applicant in said Appeal Brief for 09/232,110 (example 1 of Marchessault), the non-crystalline polyester forms a film with little or no strength (little or no fusion) at ambient temperature which rebuts appellant's claimed fusion at

ambient temperature and appellant's own argument that said aqueous (co)polyester alone would form a water-resistant a film at ambient temperatures.

The above rejection is maintained with following response.

Applicant points the Declaration by Dr. Taylor, however, it failed to overcome the rejection due to following deficiencies; (1) Dr. Taylor states "--- in PHA polyesters, a non-crystalline or an amorphous PHA polyester alone will crystallize and/or fuse at ambient temperature to form a PHA polyester film." in section 4.". However, said PHA polyester is a crystalline polymer since it will crystallize according to Dr. Taylor which rebuts applicant's own argument. A polymer is crystalline if it crystallizes and thus said Declaration is not credible. (2) Applicant asserts that Marchessault et al teach moderately crystalline latex formulations which differ from the instant invention. However, if said Declaration is credible, it supports the examiner position in the example 1 of Marchessault et al since a crystalized non-crystalline or an amorphous PHA polyester alone would be brittle, little or no strength.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1 and 11-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marchessault et al (US 5,451,456 or WO 91/13207).

The examiner points out US'456 since US and WO are the same.

Marchessault et al teach the instant latex composition comprising non-crystalline particles in abstract and at col. 6, lines 44-50 and a coating thereof in examples. Pigments are taught at col. 6, line 68. Marchessault et al also teach employing up to 10 parts by weight of the solids of other latex polymers and copolymers at col. 7, lines 13-18. Styrenebutadiene copolymer is obtained from monomers, styrene and butadiene, obtained from petroleum (or oil) fractionation.

The instant invention further recites a method of coating surfaces such as one found on buildings over the cited art which teaches coatings on papers and synthetic latex polymer. However, one can see many paper coverings (wall papers or surface of gypsum boards which are also called "dry-wall") on surfaces of buildings.

It would have been obvious to one of ordianry skill in the art at the time of invention to utilize the coating composition comprising a polyhydroxyalkanoate (co)polyester and a room temperature film-forming latex polymer in Marchessault et al since Marchessault et al teach employing other latex polymers and copolymers, and since a room temperature film-forming paint is a routine in the art and can be found in any hardware store, and futher to use the paint thereof on paper covering on surfaces of buildings since the use of a coating composition on various surfaces is considered a routine practice and since many surfaces of bulidings are papers absent showing otherwise.

The above rejection is maintained with reason given above under 112, first PP and following response .

A white, uniform coat or film with little or no strength air dried at room temperature in example 1 does not mean it is not a water resistant and applicant failed to show otherwise. Also, a strong and/or flexible coating or film is not claimed either. If it is crystallized, then applicant's declaration (a non-crystalline or an amorphous PHA polyester alone will crystalize) supports the examiner. Marchessault et al clearly teach "in native, virgin wet state the gramules are **essentially non-crystalline**" at col. 6, lines 47-49 which rebuts applicant's assertion that PHA polyesters of Marchessault et al is a moderately crystalline.

Claims 1 and 11-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marchessault et al (US 5,451,456 or WO 91/13207) in view of Miyagawa et al (US 4,016,306).

The rejection is maintained for reason of record and reason given above.

Marchessault et al clearly teach employing the art known synthetic latex polymers and copolymers, and thus the use of a film forming latex copolymers of Miyagawa et al is a *prima facie* obviousness.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (703) 308-2389. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

THY/April 9, 2003

TAE H. YOON
PRIMARY EXAMINER